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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,530	01/04/2001	Gerald A. Lavallee	21423	2547

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EXAMINER
LEE, EDMUND H

ART UNIT	PAPER NUMBER
1732	5

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,530	LAVALLEE, GERALD A.	
	Examiner	Art Unit	
	EDMUND H LEE	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) *8-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to an injection mold, classified in class 425, subclass 116.

II. Claims 8-10, drawn to an injection molding process, classified in class 264, subclass 278.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as molding a bowling ball instead of a golf ball.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Larry Lopsure on 5/12/03 a provisional election was made without oral traverse to prosecute the invention of group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A displacing means for moving the valve pin is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The displacing means is critical because without it the valve pin would not be able to move between the positions. Thus, a displacing means must be found in independent claim 1.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon et al (USPN 6422850) in view of Inoue (USPN 5849237). In regard to claim 1, Shannon et al teach the basic claimed mold including an injection mold for applying a cover layer to golf balls (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c); upper and lower support plates each containing at least one hemispherical cavity; the upper and lower hemispherical cavities being adapted to mate to define at least one spherical cavity when the plates are brought together (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c); a plurality of retractable core pins arranged in the lower support plates and extendable into each of the lower hemispherical cavities for supporting a core of a golf ball within the spherical cavity (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c); and means for supplying fluid thermoplastic material to

each of the cavities to form a cover on the golf ball core, the supplying means including a valve pin arranged in gate in the upper plate in a center of the upper hemispherical cavity adjacent to a pole of the golf ball formed in the cavity, the valve pin being operable between a second position wherein the pin is retracted into the upper support plate out of contact with the core to allow the thermoplastic material to fill the cavity, and a third position between the wherein the pin closes the gate to stop the supply of the thermoplastic material into the cavity (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c). However, Shannon et al does not teach a first position wherein the pin extends into the cavity to engage the core and to allow thermoplastic material to enter the cavity and surround the core. Inoue teaches an injection mold for applying a cover layer to golf balls (fig 6); and retractable support pin 8 that is also capable of ejecting the molded ball (col 4, lns 8-30; fig 6). Shannon et al and Inoue are combinable because they are analogous with respect to injection molds for forming cover layers on golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the valve pin of Shannon et al to also act as a support pin as taught by Inoue in order to improve ensure proper positioning of the golf ball core of Shannon et al. In regard to claims 2-7, Shannon et al teach a displacing means (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c); a manifold 28 (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c); a valve pin having a contoured lower surface to form a dimple at the pole of the golf ball when the pin is in the third position (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c); retractable core pins arranged laterally and equally spaced about the lower hemispherical cavity (col 2, lns 57-67; col 3, lns 9-

12; col 3, lns 35-64; figs 1-2c); retractable core pins that are equally spaced about the lower hemispherical cavity and have longitudinal axes arranged substantially perpendicular to parting lines defined where the cavities terminate at a surface of the plates (col 2, lns 57-67; col 3, lns 9-12; col 3, lns 35-64; figs 1-2c). However, Shannon et al do not teach a heated manifold; and a vent pin arranged in an opening in the lower plate. In regard to a heated manifold, such is well-known in the injection mold art in order to ensure that the material remains fluid. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the manifold of Shannon et al to be heated in order to achieve the above result. In regard to a vent pin arranged in an opening in the lower plate, such is well-known in the injection molding art in order to enable the air within the cavity to escape. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a vent pin in the lower plate of Shannon et al in order to achieve the above result.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miller (USPN 5201523) teaches the state of the art of golf ball injection molds; and retractable valve pins.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD CRISPINO can be reached on 703.308.3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7718 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

EDMUND H LEE
Examiner
Art Unit 1732

6/11/03

EHL
June 16, 2003